

Remarks/Arguments:

With this Response, claims 1-12, 16, 17, and 29-31 are cancelled, without prejudicing applicants' right to prosecute these claims in a divisional or continuation application. Claims 13 and 15 are amended. Claims 32-67 are new and are believed to be consonant with the restriction requirement. Therefore, claims 13-15, 18-28, and 32-67 are pending.

The amendments to claim 13 and new claims 32-67 are supported by the application. With respect to claim 13, for example, imprinting the bag with cooking directions is characterized as a *preferred* embodiment. See page 7, lines 2 and 3 of the application. Similarly, the exclusion of heat shrink materials and meat adhesion materials is supported by claim 29 and at page 8, lines 20 and 21. The presence of and size of the gap is also characterized as preferable. Page 4, lines 10-12 and page 9, lines 4 and 5. New claims 32, 36, 55, and 59 are supported at page 6, lines 2 and 3. Claims 35 and 58 are supported at page 6, lines 8 and 9. The concept that the package comprises the bag and an outer container is described at page 7, lines 2-5 and at page 8, lines 5-7. Support for the other claims can be found in the claims as originally filed or plainly set forth elsewhere in the application. Accordingly, no new matter has been added.

I. The Office Action

The Office Action rejects claims 13-19 and 21-28 under 35 U.S.C. § 102(e) as anticipated by Berrier et al. (U.S. Application Publication No. 2004/0121054). Claim 20 stands rejected by the Office Action under 35 U.S.C. § 103(a) as obvious over Berrier in view of Hoffman (U.S. Patent No. 3,454,211). The Office Action states that Berrier fails to provide a bag with chamfered corners and cites Hoffman as teaching corners disposed at a 45° angle. The motivation provided by the Office Action to modify Berrier in view of Hoffman is because the "curved ends will help reduce the stress concentration at the corners to prevent the bag from bursting."

II. The Applicants Response

The applicants have amended the claims and present four independent claims, namely claims 13, 39, 64, and 65. The applicants submit that these independent claims are not anticipated by Berrier. With respect to claims 13 and 64, for example, the applicants contend

that one of ordinary skill in the art could not have at once envisaged the subject matter within these independent claims based on the Berrier reference.

A. The Law

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). The claimed invention may not be dissected into discrete elements to be analyzed in isolation, but must be considered as a whole. See, e.g., *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1548 (Fed. Cir. 1983). This rule of law is most true when the prior art discloses a plethora of possibilities (i.e., a genus), but the claimed invention is directed to a specific combination of elements (i.e., a species). The MPEP § 2131.02 provides guidelines to apply this genus/species rule of law through the example of a chemical compound. Section 2131.02 sets forth when a generic chemical compound will anticipate a claimed chemical compound species covered by the generic chemical compound: when the claimed chemical compound species can be "at once envisaged" by one of ordinary skill in the art from the disclosure of the generic chemical compound. When the chemical compound species is not specifically named, but instead it is necessary to select portions of the teachings within a reference and combine them, e.g., by selecting various substituents from a list of alternatives for a given feature, anticipation can only be found if the disclosed list of substituents are sufficiently limited or well delineated. *Ex parte A*, 17 USPQ2d 1716 (Bd. Pat. App. & Inter. 1990). Thus, if one of ordinary skill in the art is able to "at once envisage" the specific compound within the list of alternatives, the compound is anticipated. One of ordinary skill in the art must be able to write the name of each of the compounds included in the generic formula before any of the compounds is "at once envisaged."

B. Claims 13 and 64 would not have been at once envisaged from the disclosure of Berrier.

Applying the above rule of law, the generic chemical compound can be likened to Berrier's generic disclosure of a film formed into a bag in which meat may be cooked or reheated. The various substituents of the generic chemical compound are similar to the various features of Berrier's film, e.g., the number of layers in the film, the type of polymer(s) in the film, and the percentage of those respective polymers. For each of these features, Berrier discloses a plethora of alternatives.

As stated above, anticipation can only be found if the disclosed list of alternatives for each substituent is sufficiently limited or well delineated. In this particular case, anticipation can only be found if the list of alternatives for each of the features of the film disclosed in Berrier are sufficiently limited or well delineated such that one of ordinary skill in the art could have at once envisaged the presently claimed specific combination.

On first impression, the applicants find no express teaching in Berrier where there is a clear indication that Berrier contemplated the combination of the features claimed by claims 13 and 64. There is no paragraph, line, or example in Berrier found by the applicants that resemble the particular features as now claimed in the independent claims. As a consequence, to anticipate the present claims, one of ordinary skill in the art must do what Berrier fails to do - assemble from the disclosed list of alternatives given for each feature, that specific alternative for that specific feature and combine them to form the specifically claimed combination. The applicants challenge the anticipation rejection on this point and submit that one of ordinary skill in the art would not have at once envisaged the subject matter now claimed from the plethora of possibilities listed in Berrier.

Claims 13 and 64 require the following features, among others: (1) a single layer bag comprising (2) nylon 66 (3) in at least 90% by weight. These three claimed features must be considered as a whole. As such, the applicants present the possibilities that one of ordinary skill in the art would have selected the particular combination of claimed features from the list of alternatives for each of these film features disclosed in Berrier. For each feature, the applicants present the possibility, by chance alone, that one of ordinary skill in the art would have selected the same feature as claimed from the list of alternatives disclosed in Berrier to demonstrate that Berrier's disclosed list of alternatives are not sufficiently limited or well delineated. The applicants also identify the cumulative probability (the multiple of individual probabilities) that the specific combination of features would have been selected by one of ordinary skill in the art. The applicants submit that the small probability of successfully selecting the combination of claimed features demonstrate that one of ordinary skill in the art would not have at once envisaged the claimed invention based on the teachings of Berrier.

C. Selection of Claim Elements of Claims 13 and 64

First, one of ordinary skill in the art (without the knowledge gleaned from applicants' disclosure) must have selected the same number of layers in the film as in claim 13 (i.e., a

single layer). Berrier at paragraph [0017] discloses that "A useful film may comprise, for example, one layer, two layers, at least 2 layers, at least 3 layers, at least 4 layers, at least 5 layers, from 2 to 4 layers, from 2 to 5 layers, and from 5 to 9 layers." Berrier discloses nine (9) different layer options to choose from. One of ordinary skill in the art has a 1 in 9 or 11.1% probability of selecting the same number of layers as in claim 13 (i.e., a single layer) if such a selection is by chance alone and without the knowledge of applicants' invention. On this point, it should be noted that Berrier is primarily directed to a multi-layer film, and a single layer film is only mentioned in passing.

Next, one of ordinary skill in the art must have at once envisaged the composition of that single layer. At paragraph [0018] Berrier discloses the options that: "The film may comprise one or more polyamides, one or more polyesters, or a blend of polyamide and polyester" Berrier discloses five (5) different possible general compositions of that layer: 1) one polyamide, 2) more than one polyamide, 3) one polyester, 4) more than one polyester, and 5) a blend of polyamide and polyester. Because nylon 66 is a polyamide, one of ordinary skill in the art has a 3 in 5 or 60% probability of selecting the same class of compositions as in the independent claims (i.e., comprising nylon 66).

If one of ordinary skill in the art successfully selects a single layer (11% probability) and then selects that the layer has a composition that is one or more polyamides (60% probability), and that selection was by chance alone, the probability that one of ordinary skill in the art would select this combination by chance alone is 6.6% ($11\% \times 60\%$) of the time.

The next option presented by Berrier and which must have been at once envisaged by one of ordinary skill in the art is the selection of nylon 66 as the one or more polyamides. Berrier discloses at paragraph [0031]: "Useful polyamides may include those of the type that may be formed by the polycondensation of one or more diamines with one or more diacids and/or of the type that may be formed by the polycondensation of one or more amino acids." Exemplary polyamides formed are found in paragraphs [0036-38] and include 21 different possibilities of polyamides, of which nylon 66 is listed. Standing alone, one of ordinary skill in the art has a 1 in 21 or 4.8% probability of selecting nylon 66. Thus, the possibility that one of ordinary skill in the art successfully selects a monolayer (11% probability), within the class of polyamides (60% probability), of which one of the polyamides is nylon 66 (4.8% probability) from the possibilities disclosed in Berrier, and that selection was by chance alone, is 0.3% ($11\% \times 60\% \times 4.8\%$).

Finally, one of ordinary skill in the art must have at once envisaged the amount of nylon 66 in the blend from the disclosure of Berrier. At paragraph [0018], Berrier lists the percentage amounts possible for a blend of polyamides. For example, the "blend of polyamide . . . [may be] in an amount of any of the following ranges based on the weight of the film: at least about 70%, at least about 80%, at least about 90%, at least about 95%, at least about 96%, and at least about 98%. Further, the film may comprise about 100% . . . [of the film]." Thus, Berrier discloses seven (7) possibilities for the amount of one polyamide from the one or more polyamides. Standing alone, one of ordinary skill in the art has a 1 in 7 or 14% probability of selecting the same precise percentage amounts are required by claims 13 and 64.

In summary, the possibility that one of ordinary skill in the art successfully selects a monolayer (11% probability), polyamides as the class of composition (60% probability), which polyamide is nylon 66 (4.8% probability), in an amount of at least 90% from the possibilities disclosed in Berrier, and that selection was by chance alone, is 0.04% ($11\% * 60\% * 4.8\% * 14\%$). Thus, from the list of alternatives for each of the film features disclosed in Berrier, one of ordinary skill in the art has a 1 in 2500 probability of selecting the specific combination now claimed in claims 13 and 64. The applicants submit that this is a very minute possibility that one of ordinary skill in the art could select all the claimed features from the plethora of possibilities in Berrier without the benefit of knowing applicants' invention. One of ordinary skill in the art could not have at once envisaged the claimed invention from the disclosure of Berrier. Reconsideration of the rejection is respectfully requested.

D. Patentability of Claims 39 and 65

In the rejection of claim 13, the Office Action states: "it is inherent that the package will have directions to cook the food depending on the design of the package." Anticipation by inherency requires certainty as to the natural result of the alleged prior art teaching. As stated by the Federal Circuit:

Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. If, however, the disclosure is sufficient to show that the natural result flowing from the operation as taught would result in the performance of the questioned function, it seems to be well settled that the disclosure should be regarded as sufficient.

Continental Can Co. USA, Inc. v. Monsanto Co., 948 F.2d 1264, 1268-69, 20 USPQ 2d 1746, 1749 (Fed. Cir. 1991) (quoting *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (C.C.P.A.

1981)). See also *Schering Corp. v. Geneva Pharmaceuticals, Inc.*, 339 F.3d 1373, 1378, 67 USPQ.2d 1664, (Fed. Cir. 2003) (finding inherency of a claim directed to a metabolite of loratadine called descarboethoxyloratadine (DCL) based on a patent covering loratadine generally and noting that "DCL necessarily and inevitably forms from loratadine under normal conditions" and that "DCL is a necessary consequence of administering loratadine to patients"). The MPEP §2112 provides that to establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.

The applicants submit that it is not necessary to have printed matter on the film described in Berrier and would not be so recognized by persons of ordinary skill as inherent. In fact, Berrier is primarily directed to producing a film suitable for reheating an already-cooked meat. Other possibilities exist for communicating any directions for doing so, if needed, such as by including a separate instruction page. The applicants submit that the Examiner is establishing the inherency of the printed matter solely on the mere probability or possibility that printed matter can be applied on the package.

E. Lack of obviousness

Claim 20, which specifies that the bag includes an end having chamfered corners, stands rejected as obvious based on Berrier and Hoffman. Claims 46 and 64 also recite this feature. In addition to the reasons above, the applicants contend that these claims are patentable over the cited references for the reason set forth below.

As mandated by MPEP § 2143.03, obviousness of a claimed invention can be established only when all the claim limitations are taught or suggested by the prior art. *In re Royka*, 490 F.2d 981 (CCPA 1974). Claim 20 requires chamfered edges. The Office Action admits Berrier fails to disclose these features. Although the Office Action concludes that Hoffman discloses these features, the applicants contend that Hoffman does not disclose chamfered edges, but only curved sealing areas. The applicants submit that curved sealing areas are distinguishable from the claimed chamfered edges (compare the smooth, curves seals shown in Figs. 1 and 3 of Hoffman with sharp, chamfered edges 121 in Fig. 1 of the present application). Accordingly, because the combination of Hoffman and Berrier fails to teach each and every limitation of the claimed invention, claims 20, 46, and 64 are not obvious in view of these references. Reconsideration and withdrawal of the rejection are earnestly solicited.

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Amendment Dated January 26, 2006
Reply to Office Action of July 26, 2005

III. Conclusion

Berrier fails to teach each and every feature of the claimed invention with sufficient specificity such that one of ordinary skill in the art could have at once envisaged the claimed invention from the disclosure in Berrier. Hoffman adds nothing to fill this void of Berrier. For at least these reasons, the rejections are in error. Reconsideration is respectfully requested.

Respectfully submitted,



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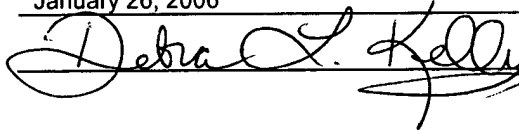
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